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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HUR, ECE

ART UNIT

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2175

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/562,948	Applicant(s) TAKAKUWA ET AL.	
	Examiner ECE HUR	Art Unit 2175	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-12,14-17 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-12,14-17 and 25-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to Response/Arguments filed on March 23, 2009.

Status of Claims

Claims 1, 3-12, 14-17, 25-30 are pending in the case. Claims 1, 9, 11, 12, 17, 28, 29 and 30 are independent Claims.

Claims 2, 13, 18-24 have been canceled.

Claims 1, 3-12, 14-17, 25-30 are rejected under 35 U.S.C. 103(a).

Response to Arguments

Applicant's arguments filed March 23, 2009 have been fully considered but they are not persuasive. See rejection for details. Applicant argued:

1) Regarding Claims 1, 3-8 rejection under 35 USC 101, the rejection is withdrawn because applicant amended the Claim.

2) Applicant argues about the amended Claims "the item information being recorded independently and separately", see rejection details.

3) Applicant argues that Figure 4 does not show a playlist, however Figure 4 and Figure 6 illustrates playlist information defining reproduction.

4) Applicant argues that in Setogawa, the plurality of buttons (reference number 2 in Figure 3 of SETOGAWA) can be displayed on only one fixed background image and cannot be displayed on another background image". However, the claims do not recite that the buttons can be displayed on another background image. Although the

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claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 12-14, 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Setogawa, EP 0898279 in view of Sugimura, US 20040252974.

Regarding Claim 1, Setogawa discloses the claimed aspect of an information recording medium readable by a playback unit for directing the operation of the playback unit, and on which recording medium there are recorded (Abstract): Content information; button information operative for defining a button menu which allows the playback unit execute an operation as for said content information (Setogawa, FIG. 3); and play list information for defining reproduction sequence by the playback unit of said content information by a unit of item (FIG. 3, Scene1, Scene2), which constitutes said content information and which is accessible upon reproduction, said button information including a plurality of button pages each of which can constitute the button menu and whose display can be changed to each other (Setogawa, FIG. 3, Scene1, Scene2, Next Page, Paragraph 0115, FIG. 10, FIG. 8, Fig 4), said button information being associated with button image information which is displayed and outputted with a background image (see Fig. 3-4), said play list information including i) item information for specifying each item which constitutes said content information (scene information); and ii) sub item information for specifying said button information as a sub item (Fig. 4), the item information including information indicating a reproduction time of the item, the sub item information including information indicating a reproduction time of the sub item ([0069], [0097]).

Setogawa does not specifically disclose the claimed aspect of the item information being recorded independently and separately from the sub item information, however Sugimura discloses the claimed aspect in FIG. 10, wherein sound information is recorded as sub play item separately from the ordinary play items. (Sugimura, Page 6, Paragraphs 0085, 0086). It would be obvious to one of ordinary skill in the art at the time of the invention to add this feature to Setogawa's play list because this would allow to play the sound information independently of the still picture. (Sugimura, Page 6, 0087).

Regarding Claim 3, most of the limitations have been met in the rejection of Claim 1. See details for Claim 1 rejection. Setogawa discloses the claimed aspect of at least one of the plurality of button pages includes button command (FIG. 3, Scene1, Scene2, and Next Page) information for defining the operation.

Regarding Claim 4, most of the limitations have been met in the rejection of Claim 1. See details for Claim 1 rejection. Setogawa discloses the claimed aspect of at least one of the plurality of button pages includes button control information being associated with at least one button image information which is displayed and outputted as the button menu (FIG. 3, Scene1, Scene2), and for displaying and outputting the button image information (FIG. 3, Scene1 is selected at step image displayed, at step 4 actual replay provided. (FIG. 3, Paragraph 0115).

Regarding Claim 5, most of the limitations have been met in the rejection of Claim 4. See details for Claim 4 rejection. Setogawa discloses the claimed aspect of button control information includes at least one of association information which indicates association with the button image information (FIG. 4, 11 is related to 15 (image) display position information which indicates a display position of a button defined by the button image information (FIG. 4, 15 (image) is related to 22 (Chapter1), and near-by button information which indicates a change in a state of the button caused by the operation, wherein the selection of BTN#1 changes the state of the button. (Setogawa, FIG. 4, Paragraphs 0084-0088).

Regarding Claim 6, most of the limitations have been met in the rejection of Claim 1. See details for Claim 1 rejection. Setogawa discloses the claimed aspect of said button information is displayed, with it superimposed on or in place of one portion of said content information (Setogawa, FIG. 3, 4, Scene1 and Scene2 are on the content information) or is not displayed at all, selectively in accordance with external designation.

Regarding Claim 7, most of the limitations have been met in the rejection of Claim 1. See details for Claim 1 rejection. Setogawa discloses the claimed aspect of said button information is recorded together with said content information (FIG. 10, relationship between button information and content is illustrated), in a content space in

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which said content information is recorded and which occupies one area of a recording area in FIG. 3, 4, 6, 10, 20, wherein menu button is used for replaying information on the recording medium (Setogawa, Paragraphs 0001, 0003).

Regarding Claim 8, most of the limitations have been met in the rejection of Claim 1. See details for Claim 1 rejection. Setogawa, discloses the claimed aspect of on which there is further recorded background image (FIG. 3, FIG. 4, background image, house) information for defining a background image on which the button menu is superimposed and displayed, wherein Scene1 selection is displayed on the background image.

Regarding Claim 9, the steps to achieve information recording medium achieves the information recording apparatus. The rejection for Claim 1 applies to Claim 9. See the rejection details for Claim 1.

Regarding Claim 10, most of the limitations have been met in the rejection of Claim 9. See details for Claim 9 rejection. The steps to achieve information recording medium achieves the information recording apparatus. The rejection for Claim 6 applies to Claim 10. See the rejection details for Claim 6.

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Regarding Claim 11, the rejection for Claims 1 and 9 apply to Claim 11. See rejection details for Claims 1 and 9.

Regarding Claim 12, Setogawa discloses an apparatus achieves the claimed aspect, the rejection for Claims 1 and 3 apply to Claim 12. See rejection details for Claims 1 and 3.

Regarding Claim 14, most of the limitations have been met in the rejection of Claim 12. See details for Claim 12 rejection. The rejection for Claim 5 applies to Claim 12. See rejection details for Claim 5.

Regarding claim 25, the rejection of claim 14 applies to claim 25.

Regarding Claim 15, most of the limitations have been met in the rejection of Claim 12. See details for Claim 12 rejection. The rejection for Claim 6 applies to Claim 15. See rejection details for Claim 6.

Regarding claim 26, the rejection of claim 15 applies to claim 26.

Regarding Claim 16, most of the limitations have been met in the rejection of Claim 12. See details for Claim 12 rejection. Setogawa discloses the claimed aspect of a buffer memory for storing the generated button menu in FIG. 13, wherein display memory 118 and 119 is illustrated. (Setogawa, Column 19, Paragraph 0119).

Regarding claim 27, the rejection of claim 16 applies to claim 27.

Regarding Claim 17, the rejection for Claims 1, 3, 4 apply to Claim 17. See the rejection details for Claims 1, 3 and 4.

Regarding Claim 28, Setogawa discloses the claimed aspect of an information recording medium on which there are recorded for enabling operation of a playback unit; an object data file for storing a first stream including video information or still picture information and a second stream including a plurality of menu information each of which is displayed in response to a user operation and can select a reproduction point of the first stream or a change of reproduction condition of the first stream in response to the user operation(Setogawa, FIG. 3); and a play list information for storing a plurality of item information each of which specifies the first stream by a unit of an item and a plurality of sub item information each of which specifies the second stream by a

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unit of a sub item, the plurality of item information and the plurality of sub item information being recorded in the play list(Setogawa, FIG. 3, Scene1, Scene2), one menu information of the plurality of menu information specified by the sub item information being superimposed on a display of the first stream during a reproduction of the first stream specified by the item information, the first stream and the second stream being recorded such that the reproduction of the video information or the still picture information included in the first stream which is reproduced before the display of the one menu information is continued, by controlling the first stream and the second stream, during the one menu information is superimposed. (Setogawa, Scene1, Scene2, Next Page, Paragraph 0115, FIGs. 3, 4, 8, 10).

Setogawa does not teach specifically the claimed aspect of the object data file and the play list information being recorded on the information recording medium independently and separately from each other, however Sugimura discloses the claimed aspect in FIG. 10, wherein sound information is recorded as sub play item separately from the ordinary play items. (Sugimura, Page 6, Paragraphs 0085, 0086). It would be obvious to one of ordinary skill in the art at the time of the invention to add this feature to Setogawa's play list because this would allow to play the sound information independently of the still picture. (Sugimura, Page 6, 0087).

Regarding Claim 29, the rejection for Claim 28 applies to Claim 29. See Claim 28 rejection for details.

Regarding Claim 30, the rejection for Claim 28 applies to Claim 30. See Claim 28 rejection for details.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ECE HUR whose telephone number is (571) 270-1972. The examiner can normally be reached on Mon-Thurs 7:30am-5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM BASHORE can be reached on 571-272-4088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

April 29, 2009

Ece Hur
E.H. /e.h.

/WILLIAM L. BASHORE/
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